

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1 through 5 remain pending in this application. Claims 6 through 22 have been cancelled. Claims 1 and 3 have been amended. Claim 1 has been amended to recite that a variably printed, personalized magnetic communication is provided on the substrate and that the material is provided from a slurry.

Claims 1 through 5 have been rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over any one of Fischer et al. US 3,108,824, Nelson et al. US 4,658,125 or Kachi et al. US 4,658,125 in view of Deetz US 5,843,329. Reconsideration and withdraw of the rejection is earnestly solicited.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Three criteria must be satisfied to establish a *prima facie* case of obviousness. First, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to modify a reference or to combine the teachings of multiple references. *Id.* Second, the prior art can be modified or combined only so long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, the prior art reference or combined prior art references must teach or suggest all of the claim limitations. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

Objective, supporting evidence is required to support an obviousness rejection. The rejection in this case also suffers from the “it is so simple that it must have been obvious” hindsight syndrome. The CAFC has recognized the tendency for such hindsight rejections and has often reiterated that they cannot stand. As stated by the Federal Circuit in reversing the rejection of applicant’s claims in the “pumpkin trash bag” case, In Re Dembiczak et al., 50 USPQ2d 1614, 1617 (CAFC 1999).

“Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (citing cases). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references...

None of the references, or combinations thereof teach, disclose or suggest a personalized communication piece in which a variable communication is printed using ferromagnetic materials and that each of the magnetic material and non-magnetic material convey a unique message.

Fisher et al. relates to a coupon that is used in a direct marketing or direct mail campaign. The coupon is detached from a periodical and then is used to scan for redemption rates. Scanning is accomplished through the use of magnetic ink and the printing of numerical indicia (see Figure 2) or a series of dots (column 6, lines 20-22) that is provided within a defined area. Fisher et al do not relate to a communication piece intended to convey or accentuate a particular message for a recipient.

Fisher et al. teach the production of a coupon and not a variably imaged, personalized communication piece as required by the claims of the present invention as amended. The magnetic ink used in the production of the coupon is intended to be recognized by electronic reading equipment not by the recipient of the coupon. See Fisher et al. column 5, line 50-52 which provides “the coded magnetic indicia to furnish a basis upon which the electronic sorting processing can later be used.”

Such MICR printing, as is well known in the industry, requires the numbers and symbols to have a distinctive shape such that the numbers and symbols can feed information to a computer that processes the information for a number of uses such as recording redemption rates, or processing checks. The indicia printed by the magnetic ink used in Fisher et al. convey little (simply a meaningless number to the recipient) or no information to the individual who comes into contact with the piece.

Moreover, the information printed using magnetic ink in Fisher et al. is printed in a well defined area (column 5, line 36). This is commonplace among documents carrying MICR printing, such as checks, in that the indicia must be in an area where it can be readily scanned by the scanning equipment, typically along an edge, commonly the bottom edge and corner. See Fisher et al. column 6, lines 12-14 where it provides the magnetic ink is printed “in the defined area, which will generally be near the bottom of the page and substantially parallel to the edge of the page...” See also column 6, lines 23-30 for a further discussion of the electronic processing equipment. Also see column 3, lines 22-24 for additional discussion on the required positioning of the ink, “the roller cluster 15 places magnetic ink on what will eventually be a defined area...”

Such a limitation, that of having to print the indicia “within a defined area” at the bottom edge of a substrate, would not lend itself well to creating a personalized communication, as a marketing or advertising personnel would not wish to be so limited

in the available space (only the bottom of the page and parallel to the edge) as this would limit the creativity of the producer and the effectiveness of the message. Thus, Fisher et al. teach away from the present invention as no personalized message is created and there is no teaching, suggestion or disclosure in Fisher et al. that would permit the reference to be modified so that the magnetic ink could be used for something other than electronic scanning of defined characters in a defined area. To suggest otherwise would destroy the purpose of Fisher et al. In this regard See Ex parte Thompson, 184 USPQ 558, 559 (Bd. App. 1974), wherein the Board held:

“The appellant notes that the central theme of the Ericson disclosure is a ceiling grid with controlled ventilation which is obtained by slotting all of the runners and by providing in association therewith apertured slide plates. The appellant also notes that Ericson teaches that the slide plates be located on the ceiling side of the grid, that they be an integral part of the runner structure, i.e., not removable without breaking or at least disassembling the runner, and that the slide plates be moveable between fully opened and closed limit positions. It is the appellant’s position that it would not be obvious to substitute the non-apertured strips of Klein for the apertured slide plates of Ericson, since to do so would destroy the Ericson, apparatus for its intended purpose. We agree with the appellant’s position and, thus, we do not sustain the rejection of the appealed claims.”

Nelson et al. describe “encodable envelope inserts which have a configuration of code bits, in the form of bars of magnetizable ink...” (column 1, lines 5-6) and “each card usually has a coded instruction applied thereto by machine and no provisions is made for allowing a user to manually vary or establish the coded instruction” (emphasis added) (column lines 18-22). Nelson et al. clearly teach away from providing an advertising or personalized communication piece in that a user cannot establish what is hidden in the code and can only tear off or select the number of units one wishes to order from a generic insert (column 3, lines 43-55) as one bar corresponds to one unit. That is, the bar contains no discernable message, and merely appears as a black bar, which has little or no marketing or advertising value.

Like Fisher et al., Nelson et al. require that the printed bars are limited by their positioning and use. See for example, column 1, lines 45-51 “regardless of the number of detachable portions removed therefrom, it can be placed in its envelope only with its longitudinal centerline parallel to the longitudinal centerline of the envelope to further assure proper reading by the code sensor” (emphasis added). Again, in developing a particular marketing or advertising campaign, a customer or designer would not wish to be confined or limited to the manner in which his or her magnetic message is displayed. Likewise, to suggest that the bars could be positioned differently, used in some other manner than for electronic scanning or take on some other form would then not permit the invention described in Nelson et al. to be practiced as the bars could not be scanned through the envelope. Thus, the modification proposed of Nelson et al. would again destroy the purpose of the invention.

The foregoing passage also suggests that the user does not actually glean any marketing or advertising information from the coded bars or any personalized message but rather simply tears off portions of insert which must then be reinserted into an envelope for electronic reading and scanning which indicates to the issuer how many units of a product the user wishes to order. Thus, the communication accomplished by the Nelson et al. insert is actually accomplished without being visible, that is, the information is transmitted though the walls of the envelope.

In addition, Nelson et al. teach that the “advertising matter, operating instructions and the like may be non-magnetically printed onto the insert with-out affecting the magnetic coding thereof” (emphasis added) (column 1, lines 59-62). Thus, Nelson et al. specifically teach away from the claimed invention of using a ferromagnetic material to print the personalized or advertising message or portion thereof.

Kachi et al. relate to a coupon having a series of "data trains" printed with magnetic ink that are provided in "predetermined positions" so that the data may be read by electronic scanning equipment. As with each of Nelson et al. and Fisher et al. the magnetic ink is not provided to convey a personalized message to the recipient but rather is used solely for the purposes of scanning by electronic equipment.

Moreover, Figures 5A and B and associated text (column 3, lines 12-25) disclose that the magnetic ink data trains can be overprinted and concealed so as to "camouflage" the magnetic ink. Clearly, if one intends to hide or camouflage the magnetic ink, the ink or the indicia printed therewith is not intended then to be part of the marketing or personalized communication message because it cannot be seen. This demonstrates that the ink is not intended to be part of the marketing campaign of the coupon and is only used for electronic scanning and reading.

Deetz does not remedy the deficiencies of Kachi et al. If one were to take the teachings of Deetz and combine them with Kachi et al., or for that matter either Nelson et al. or Fisher et al., the result is simply a coupon having MICR type printing or data trains that use an allegedly economical magnetic ink that are then to be scanned by electronic equipment. If applying the teachings of Deetz to that of Kachi et al., those magnetic printed areas may even be camouflaged. In any event, the combination does not result in a personalized communication message printed with ferromagnetic material.

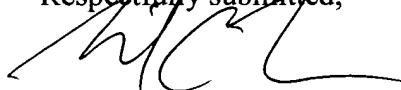
The cited references all pertain to coupons or redemption pieces in which there is no variability between coupons and the message that is presented to the end user. The references do not suggest or teach a communication piece where each of the non-magnetic and magnetic portions convey unique information to the recipient. They instead disclose the use of magnetic inks for electronic scanning or reading. In addition, none of the references, or combination of the references, teach or suggest the creation of a personalized, magnetic message.

There is no variability between coupons or personalized messages. Coupons are issued in large numbers in the hopes of increasing the use and purchase of products. Each coupon allows a recipient to redeem a similar product, and there is no unique message delivered to the recipient. With the present invention, a variable, personalized message can be created from a magnet material that compliments the marketing message which is printed with non-magnetic inks.

Applicants respectfully request the reconsideration and withdraw of the rejection.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited. The Examiner is encouraged to contact the undersigned in the event any small matters remaining outstanding so as to eliminate the necessity of another action and response.

Respectfully submitted,



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